

REMARKS

The above amendments and following remarks are submitted under 37 C.F.R. 1.116 in response to the Final Official Action of the Examiner mailed June 3, 2005. Having addressed all objections and grounds of rejection, originally presented claims 1-20, being all the pending claims, are now deemed in condition for allowance. Entry of this amendment and reconsideration to that end is respectfully requested.

Claims 1-4, 6-9, 11-14, and 16-19 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,434,619, issued to Lim et al (hereinafter referred to as "Lim"). This ground of rejection is respectfully traversed for the following reasons.

The process for finding anticipation during the examination process is specified by MPEP 2131 which provides in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM
"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The rejection is respectfully traversed because Lim does not expressly or inherently describe "each and every element as set forth in the claim".

The essence of the present invention as disclosed and claimed requires a user terminal coupled to a data base management system via a publicly accessible digital data communication network having a customized user interface module which is itself coupled to the user terminal via the publicly accessible digital data communication network. It is not in the claimed user terminal. The importance of this architecture is explained in detail in Applicants' specification providing various types of customized user interfaces associated with the various applications.

This feature was carefully pointed out to the Examiner in Applicants' previous submission. In response thereto, the Examiner states at page 5, paragraph 15A. of the pending officiation action:

As to point (1), there is no (sic) any language in the claim 1 directs (sic) to the limitation that the user interface module should be physically separated from or detached to (sic) the user terminal. Furthermore, applicant claimed the user interface module "coupled to" the user terminal, (sic) it does not specify these two elements could not be attached together. (Emphasis added)

It is admitted that claim 1, as previously presented, states:

....a user interface module coupled to said user terminal via said publicly accessible digital data communication network....

As explicitly stated, the claimed coupling is "via said publicly accessible digital data communication network". It defies understanding that the Examiner could find that the "customer

end-user browser" of Lim would be coupled to the computer which hosts it via said publicly accessible digital data communication network.

Nevertheless, because the Examiner has apparently misunderstood the claim language as previously presented, claims 1 and 6 have been further amended to more explicitly require that the claimed "user interface module" is located within the data base of the remote data base management system.

Because claims 11 and 16 have not yet been examined in accordance with controlling law, the Examiner has apparently not yet read that these claims as originally presented were so limited. Claim 11, for example, states at step b:

....receiving said service request with a user interface module located within said remote server;
(emphasis added)

Thus, there should be no confusion concerning the location of the claimed "user interface module" and especially no confusion concerning the claimed "user interface module" which cannot be the "customer end-user browser" of Lim as alleged by the Examiner.

In their previous response, Applicants attempted to clarify the location of the major elements by indicating that the claimed "application" and "user interface module" of claim 4 are located within a single server. In response to this explanation, the Examiner states:

As to point (2), applicant fails to consider the teaching of Lim for including "service application" and client user interface module in server [col. 4, lines 4061], (sic) applicant should consider the teaching of entire system, not only focus on one single drawing.

In addition to its content, Applicants are confused with the reason for this statement. Applicants have referenced Fig. 2 of Lim, because the Examiner has stated and continues to state in the pending official action at page 2, paragraph 4:

As per claims 1-2 Lim teaches the invention as claimed including a data processing system having a user terminal for accessing an application [CSM service director, Fig. 2] coupled to a data base management system [CSM agent, Fig. 2] responsively coupled to said user terminal via a publicly accessible digital data communication network [col. 2, lines 20-30], the system comprising a user interface module coupled to said user terminal [customer end-user browsers, Fig. 2]....

In short, it is the Examiner who has read the elements of claims 1-2 (from which claim 4 depends) onto Lim Fig. 2.

In addition, the Examiner has finally rejected claims 1-2 alleging that the claimed "application" is found in CSM service director of Lim and that the claimed "user interface module" is found in customer end-user browsers of Lim. Thus, he has rejected claims 1-2 upon the system of Lim wherein the claimed "application" and claimed "user interface module" are not co-located. He then somehow rejects claim 4 which depends from claim 1-2 (and so contains all of the limitations of claims 1-2 as a matter of law) alleging that the claimed "application" (i.e., CSM service director) and the claimed "user interface

module" (i.e., customer end-user browsers) are co-located. The pending official action is internally inconsistent.

Similarly, in Applicants' previous response, the Examiner's failure to comply with MPEP 2143 in showing "motivation" to combine references was indicated. In response thereto, the Examiner states:

As to point (4), the motivation for combining both references are based on the knowledge of one person of ordinary skill in the art and logical reason, (sic) it is not based on examiner's assumption. Accordingly, both references are relevant references. (Emphasis added)

Of course, the issue here is "motivation" not "relevancy".

Furthermore, this holding is contrary to controlling law. MPEP 2143.01 states in part:

The level of skill in the art cannot be relied upon to provide suggestion to combine references. *Al-Site Corp. V. VSI Int'l Inc.* 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

The Examiner simply has not met his burden under MPEP 2143.

Specifically, with regard to the rejection of claim 1, the Examiner states:

As per claim 1-2, Lim teachesthe system comprising a user interface module coupled to said user terminal [customer end-user browsers, Fig.1] via said publicly accessible digital data communication network [www, Fig. 2].....

This finding appears to be clearly erroneous. If the "Customer End-User Browsers" of Lim's Fig. 2 are found to be the claimed "user interface module", there are no claimed user terminals

coupled to the customer end-user browsers via the claimed publicly accessible digital data communication network. Therefore, the rejection of claim 1, and all claims depending therefrom, is respectfully traversed as based upon clearly erroneous findings of fact.

Claim 2 depends from claim 1 and further limits the "publicly accessible digital data communication network". Because Lim does not meet the limitations of claim 1, it cannot meet the further limitations of claim 2. The rejection of claim 2 is respectfully traversed.

Claim 3 depends from claim 2 and further limits the software architecture of the "User Terminal". Lim says nothing of software architecture and certainly shows nothing of software architecture in Fig. 2. The rejection of claim 3 is respectfully traversed as based upon clearly erroneous findings of fact.

Claim 4 depends from claim 3 and further requires that the "application" and the "user interface module" are located within a single server. A brief glance at Fig. 2 shows that Lim cannot meet this limitation. In accordance with Fig. 2, "Customer End-User Browsers", which the Examiner has found to correspond to the claimed "User Interface Module" is coupled via the "www" to "CSM Service Director", which the Examiner has found to correspond to the claimed "application". As explained above, the Examiner has responded to this issue by making internally inconsistent

findings, which are contrary to controlling law. Therefore, Lim cannot meet the limitations of claim 4. The rejection of claim 4 is respectfully traversed.

In rejecting claims 6-9, the Examiner clearly erroneously states:

As per claims 6-9, since (sic) they are apparatus claims of claims 1-4, they are rejected for the same basis as claims 1-4 above.

Claims 1-4 and 6-9 are not of the same scope. For example, claim 6 is limited by "an application responsively coupled to said user interface module via said data base management system". This limitation is simply not found in claims 1-4. Apparently, the Examiner simply refuses to examine 6-9. Therefore, in addition to the clearly erroneous findings of fact with regard to the rejection of claims 1-4, the rejection of claims 6-9 is respectfully traversed as incomplete as a matter of controlling law.

In rejecting claims 11-14, the Examiner clearly erroneously states:

As per claims 11-14, since (sic) they are method claims of claims 1-4, they are rejected for (sic) the same basis as claims 1-4 above.

Claim 11, for example, is a method claim having four steps. Lim has none of these four steps. Furthermore, the Examiner has refused to even examine this claim in opposition to controlling law.

This matter had been brought to the Examiner's attention in their response to the initial office action. In response thereto, the Examiner concludes:

AS to point (3), Lim teaches the detail (sic) steps for handling requests as application claimed in claims 11-14 [col. 5, lines 9-45].

Though this extensive citation may discuss how Lim handles requests, it has nothing to do with claim 11.

For example, claim 11 requires "transferring", "receiving", "storing", and "retrieving". Lim does not have any of these steps as claimed. In addition to the clearly erroneous findings of fact identified above, the rejection of claims 11-14 is respectfully traversed as being incomplete as a matter of law.

In rejecting claims 16-19, the Examiner again fails to apply controlling law. Failing to acknowledge the difference in statutory basis and the examination procedures mandated by MPEP 2181 et seq., the Examiner states:

AS per claims 16-19, since (sic) they are means plus function claims of claims 1-4, they are rejected for (sic) the same basis as claims 1-4 above.

In addition to the clearly erroneous findings of fact explained above, this ground of rejection is clearly incorrect as a matter of law.

Furthermore, Lim does not appear to have the claimed "offering means" or "processing means". Similarly, claims 1-4 do

not have the limitations of claim 19 as specifically admitted by the Examiner in paragraph 12 stating:

Lim does not specifically teach the data base management system is Classic MAPPER.

Though the inconsistency has been previously pointed out to the Examiner, he continues in his clearly contradictory findings. The rejection of claims 16-19 is respectfully traversed as based upon clearly erroneous findings of fact and incorrect/inadequate application of controlling law.

Claims 5, 10, 15, and 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Lim in view of U.S. Patent No. 6,446,117, issued to Gebauer (hereinafter referred to as "Gebauer"). This rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143.

In making an obviousness rejection, the Examiner has the burden of making showings of: 1) motivation; 2) reasonable likelihood of success; and 3) all claim limitations. The Examiner has not even mentioned his obligation to make the second showing or the clear teachings of Gebauer which teach against the alleged combination.

Furthermore, with regard to motivation, Applicants have previously indicated the Examiner's lack of showing in accordance with MPEP 2143. As explained above, based upon the Examiner's currently holdings, it seems clear that he simply refuses to

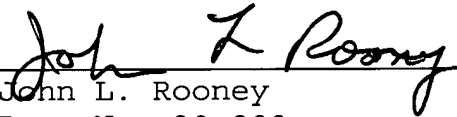
apply controlling law. The Examiner has instead chosen his own standard which is specifically disclaimed by MPEP 2143.01.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,
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By their attorney,

Date August 3, 2005


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